PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Jing Li, et al.	Atty. Docket No.:	6539.00046
Confirmation No.	2334		
Application No.:	10/073,123	Group Art Unit:	1635
Filed:	February 12, 2002	Examiner:	Amy Hudson Bowman
For:	AMPLIFIED CANCER GENE WIP1		

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the Office Action mailed May 3, 2005 which set a one (1) month shortened statutory period for response. In the event a fee needs to be paid to enter this response, please charge Deposit Account No. 19-0733 for any such fee.

The Office Action requires restriction between what are asserted to be fifteen (15) separate and distinct inventions:

Group I – Claims 1-3 to a method of diagnosing cancer involving the WIP1 gene copy number

Group II – Claims 5 and 8 to a method *inter alia* of inhibiting cancer using an antisense nucleotide which interacts with WIP1 DNA or RNA

Group III – Claims 6 and 8 to a method *inter alia* of inhibiting cancer using an ribozyme which interacts with WIP1 DNA or RNA

Group IV – Claims 7 and 8 method *inter alia* of inhibiting cancer using a nucleotide that forms a triple helix with a WIP1-encoding nucleic acid which interacts with WIP1 DNA or RNA

Group V – Claims 9-11 to a method of monitoring the effectiveness of a treatment using a measurement of WIP1 copy number

Group VI – Claim 12-14 to a method of diagnosing cancer measuring the level of WIP1

mRNA transcripts

Group VII – Claims 16, 17 and 21 to a method *inter alia* of inhibiting cancer using an antibody inhibitor of WIP1 protein

Group VIII – Claims 16, 18 and 21 to a method *inter alia* of inhibiting cancer using an antagonist inhibitor of WIP1 protein

Group IX – Claims 16, 19 and 21 to a method *inter alia* of inhibiting cancer using an antagonist inhibitor of the 12-lipoxygenase activity of WIP1 protein

Group X – Claims 16, 20 and 21 to a method *inter alia* of inhibiting cancer using an a small molecule inhibitor of WIP1 protein

Group XI – Claims 22-24 to a method of monitoring the effectiveness of a treatment using a measurement of WIP1 mRNA or WIP1 expression levels

Group XII – Claims 25-31 to an isolated WIP1 gene amplicon

Group XIII – Claim 32 to a method of making a pharmaceutical composition

Group XIV – Claims 33-35 to a method of diagnosing cancer by detecting WIP1 protein expression, and

Group XV – Claims 36-38 to a method using a small molecule to modulate WIP1 activity.

In response to the Restriction Requirement, applicants elect the invention of Group I, claims 1-3.

The Office Action fails to present sufficient justification why the invention of Groups I and V should be restricted one from the other. The methods of Group I and V both involve the measuring of WIP1 gene copy number. In Group I, the gene copy number serves as a basis for a diagnosis of cancer and in Group V it provides an indication of the effectiveness of a given cancer treatment therapy. However, the basic use of gene copy number (amplification) ties both sets of claims together. The contention in the Office Action that searching both claim sets would be burdensome is mere speculation. The focus on WIP1 gene copy number in both claims as a defining feature of the claimed subject matter makes any search of their patentability substantially coextensive. Applicant submits that the claims of Group I and Group V should be examined together. Given the nature, scope and inter-relationship of these claims, no burden is

presented by their common examination.

The Office Action also presents a requirement for an election of species. In response to this requirement, applicants select breast tissue (cancer). All of the claims would embrace the relevant method(s) applied to breast tissue (cancer).

Applicants request consideration of the pending claims.

Respectfully submitted,

Dated: June 2, 2005

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